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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,326	03/04/2002	Tony E. Godfrey	010211	5534

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EXAMINER

WILDER, CYNTHIA B

ART UNIT PAPER NUMBER

1637

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/090,326	Applicant(s) GODFREY ET AL.	
	Examiner Cynthia B. Wilder, Ph.D.	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53, 59-61, 63-66 and 78-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 61, 63-66, 78-81, 84 and 86 is/are allowed.
- 6) ☒ Claim(s) 1-59, 82, 83 and 85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1637

DETAILED ACTION

1. Applicant's amendment filed on July 22, 2004 is acknowledged and has been entered. Claims 3, 10, 34, 39, 40, 60, 81 and 84 have been amended. Claims 54-58, 62, 67-77 and 87-104 have been canceled. Claims 1-53, 59-61, 63-66, 78-86 are pending. All of the amendments and arguments have been thoroughly reviewed and considered but are deemed moot in view of the new grounds of rejections. Allowability of claims 1-53, 59, 65, 66 and 82, 83, and 85 is withdrawn in view of the new grounds of rejections. Claims 78-81, 84 and 86 contain allowable subject matter. Any rejection not reiterated in this action has been withdrawn as being obviated by the amendment of the claims.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

3. The information disclosure statement filed July 22, 2004 is acknowledged. A signed copy of the 1449 is submitted with this Office action.

Previous Rejections

4. Claim rejections under 35 USC 112 second paragraph directed to claims 3, 10, 34, 39, 40, 81 and 84 are withdrawn in view of Applicant's amendment of the claims. The prior art rejection under 35 USC 102(a) directed to claim 60 as being anticipated by Boehringer Mannheim is withdrawn in view of Applicant's amendment of the claims. The prior art rejection under 35 USC 103(a) directed to claims 61 and 64 as being unpatentable over Boehringer Mannheim in view of Anderson et al is withdrawn in view of Applicant's amendment of claim 60.

Art Unit: 1637

New Grounds of Rejections

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-59, 82, 83, and 85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1-59, 82, 83 and 85 are indefinite in claims 1, 30, 59, 82, 83 and 85 for the recitation of "modulate the relative rate" because the specification does not define what is meant by "modulate" or "relative" and thus the metes and bound of the terms as they relate to the claim method cannot be ascertained. Clarification is required.

(b) Claims 4, 5, 19, 35, 36 are indefinite at the recitation of "derivative thereof" because the definition at paragraph 0039 is ambiguous and it cannot be determined what modification are required to obtain the primers as required for the instant invention. It is suggested deleting "derivative thereof".

(c) Claim 37 is indefinite because the claim is incomplete. The claim ends with the word "and" and no punctuation. There for it cannot be determined Applicant's intent. Clarification is required.

Conclusion

6. Claims 1-59, 82, 83, and 85 are not allowed. Claims 61, 63-66, 78-81, 84 and 86 contain allowable subject matter.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is

Art Unit: 1637

(571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to cynthia.wilder@uspto.gov. Since email communications may not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

PATENT EXAMINER
CYNTHIA WILDER

Cynthia Wilder
9/29/2009